

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

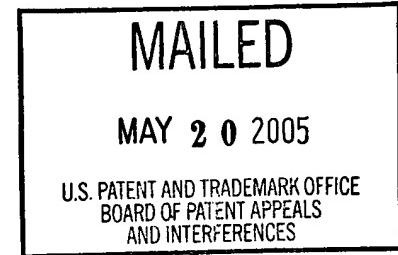
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL LEE VATTER,
JORGE MAX SUNKEL, and
CURTIS BOBBY MOTLEY

Appeal No. 2004-1788
Application No. 09/902,321

ON BRIEF



Before WILLIAM F. SMITH, MILLS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-14. Claim 1 is representative of the subject matter on appeal, and reads as follows:

1. A stable multiphase emulsion composition, comprising:
 - A.) a continuous phase, comprising:
 - i.) an emulsifying crosslinked siloxane elastomer; and
 - ii.) a solvent for the emulsifying crosslinked siloxane elastomer;

B.) at least one discontinuous phase, comprising:

i.) solid particles

wherein the discontinuous phase has a droplet size range of from about 0.1 microns to about 100 microns and wherein the particles are uniformly distributed on the skin independent of skin topography.

The examiner relies upon the following references:

Tachibana et al. (Tachibana) 5,412,004 May 2, 1995

Hawley, The Condensed Chemical Dictionary, 10th Ed., pp. 121, 385, 434, and 686 (1981)

Claims 1-10 and 12-14 stand rejected under 35 U.S.C. § 103(a) over Tachibana. In addition, claim 11 stands rejected under 35 U.S.C. § 103(a) over the combination of Tachibana and Hawley. After careful review of the record and consideration of the issues before us, we affirm.

DISCUSSION

Claims 1-10 and 12-14 stand rejected under 35 U.S.C. § 103(a) over Tachibana. As the claims stand or fall together, see Appeal Brief, page 3 we focus our analysis on the broadest claim, claim 1.

Tachibana is cited for teaching "the manufacture of paste-like silicone compositions that can be used in water-in-oil emulsions," and, as noted by the examiner, the specification acknowledges that the emulsifying crosslinked siloxane elastomers of encompassed by the claimed invention may be chosen from those taught by Tachibana. Examiner's Answer, page 3; see also Specification, page 5, lines 8-10. Tachibana is also cited for teaching that the

water-in-oil cosmetic emulsion "may contain various components in the discontinuous phase such as saccharides, sugar alcohols, inorganic salts, polyoxyalkylene-modified organopolysiloxane emulsifiers (surfactants) and cosmetic powders, such as talc, kaolin, mica, titanium dioxide, zinc oxide, red iron oxide, and others." Examiner's Answer, page 3.

The rejection concludes:

Tachibana does not disclose the droplet size distribution range of the discontinuous phase, the average particle size of the emulsifying crosslinked siloxane elastomer It is well within the skill of the art to select optimal parameters in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 1988). Therefore, absent evidence of unexpected results, it is considered within the skill in the art to select optimal droplet size and particle size in the compositions of Tachibana for aesthetic purposes.

* * *

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select an optimal droplet size of the discontinuous phase and particle size of the emulsifying siloxane elastomer in the compositions of Tachibana expecting to obtain stable cosmetic water-in-oil emulsions that provide good feeling upon use.

Id. at 4-5.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citations omitted). The test of obviousness is "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention."

In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). We find that the rejection over Tachibana sets forth a prima facie case of obviousness.

Appellants argue that Tachibana "fails to teach or suggest a composition as appellants currently claim that includes a solid particle-containing discontinuous phase wherein the discontinuous phase has a droplet size distribution range of from 0.1 microns to 100 microns. Moreover, the reference fails to teach or suggest that such particles are uniformly distributed on the skin independent of skin topography." Appeal Brief, page 4.

As noted by the rejection, Tachibana teaches a water-in-oil, paste-like silicone composition comprising the components of the continuous phase as required by claim 1, and a discontinuous phase comprising a water phase component and a cosmetic powder. See Tachibana, Col. 4, lines 12-18. The cosmetic powder may be talc, kaolin, mica, etc., see id. at col. 10, line 61-col. 11, line 6, which are some of the same solid particles included in claim 9 of the appealed claims. A foundation prepared according to the invention of Tachibana containing titanium dioxide, mica and pigment as the solid particles was disclosed as giving "a fresh sensation upon use without stickiness. It spread excellently over the skin producing a homogenous cosmetic film and exhibiting superior make-up retentivity." Col. 20, lines 6-48 (emphasis added).

Tachibana admittedly fails to teach or suggest that the discontinuous phase of the cosmetic composition has a droplet distribution range of from about

0.1 microns to about 100 microns. In fact, Tachibana fail to disclose any size range for the droplet size distribution range of the discontinuous phase. Tachibana does teach, however, that in order to achieve a homogenous composition, the components are kneaded with a triple roll mill. See id. at col. 7, line 61-col. 8, line 4; col. 20, lines 33-35. As the present specification teaches that the compositions may be "prepared by conventional formulation and mixing techniques," page 21, lines 20-21, and specifically exemplifies the use of a three mill roll, page 22, lines 5-6, it would have been obvious to the ordinary artisan to optimize the droplet size distribution of the discontinuous phase to achieve a cosmetic composition wherein the particles are uniformly distributed on the skin, i.e., homogenous application to the skin. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill in the art." (citations omitted)); see also In re Peterson, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003).

Appellants argue further that "Tachibana fails to teach or suggest the delivery of powder or pigmented solids via the discontinuous phase of an emulsion composition." Appeal Brief, page 4. Appellants assert that while the rejection relies on Tachibana for identifying solids such as sugars, sugar alcohols, and inorganic salts for use in the water phase of its composition, that such solids would prevent uniform deposition of such particles on the skin. See id.

As noted above, Tachibana teaches a cosmetic composition comprising an oil phase, a water phase and a solid particle, such as mica, which are the same components required by appealed claim 1. While appellants argue that the delivery of the solid particle in the invention of Tachibana is via the oil phase, whereas in the instant invention the delivery is via the water phase, there is no evidence to that effect on the record, and arguments of counsel cannot take the place of evidence in the record. See In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974); In re DeBlauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Moreover, Tachibana specifically teaches that their cosmetic compositions are applied homogenously to the skin. With respect to the use of solid phase components such as sugars, sugar alcohols, and inorganic salts, the composition of Tachibana does not require the addition of those components, nor do the instant claims exclude them. Finally, while appellants contend that that such solids would prevent uniform deposition of such particles on the skin, again, they do not point to any evidence of record to support that assertion.

Finally, appellants argue that "the Office has rejected the aforementioned claims under an assertion of obviousness yet relies on a rationale of inherency." Appeal Brief, page 5. The rejection, however, is not premised on a rationale of inherency. Rather, the basis of the rejection is that it would have been obvious to optimize a result effective variable, and as such, is affirmed.

Claim 11 stands rejected under 35 U.S.C. § 103(a) over the combination of Tachibana and Hawley. Appellants, however, merely argue that Hawley fails to remedy the deficiencies of Tachibana, see Appeal Brief, page 5, and thus this rejection is also affirmed for the reasons set forth supra.

CONCLUSION

Because the rejections under 35 U.S.C. § 103(a) set forth a prima facie case of obviousness, they are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


William F. Smith
Administrative Patent Judge)
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Demetra J. Mills
Administrative Patent Judge)
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BOARD OF PATENT
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APPEALS AND
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INTERFERENCES
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